

Application no. 10/068,710
Amdt. dated March 2, 2004
Reply to Office Action of December 2, 2003

REMARKS / ARGUMENT

A. INTRODUCTION

In the office action dated December 2, 2003 (hereafter "office action"), claims 1-23 were rejected under 35 U.S.C. § 103(a) under U.S. patent no. 6,047,326 to Kilkki (hereafter "Kilkki") in view of U.S. patent no. 6,252,849 to Rom *et al.* (hereafter "Rom").

B. REJECTION UNDER 35 U.S.C. § 103: MOTIVATION TO COMBINE

Applicant asserts that claims 1-23 are allowable because Examiner has not established a prima facie case of obviousness. Examiner has stated that one skilled in the art would be motivated to "incorporate the use of switch controller as taught by Rom *et al.* into the invention of Kilkki to achieve the advantage of fairly allocating network resource." (office action, page 3, lines 2-4). This statement, however, (a) fails to indicate what network resources Kilkki and Rom are combined to fairly allocate, (b) fails to state where in the prior art the advantage of fair network resource allocation is suggested, and (c) fails to provide a motivation to combine Kilkki and Rom, specifically, to achieve the advantage.

If Examiner should feel compelled to maintain the rejection, Applicant respectfully requests that Examiner establish a prima facie case of obviousness and augment the stated motivation by identifying what resource is being allocated if Kilkki and Rom were combined and where in the prior art there is some teaching or suggestion to choose Kilkki and Rom and to then combine them to produce the present invention. Ex parte Skinner, 2 USPQ 2d 1788, 1790 (B.P.A.I. 1986) (When the incentive to combine the teachings of the references is not readily apparent, it is the duty of the examiner to explain why combination of the reference teachings is proper. . . . Absent such reasons or incentives, the teachings of the references are not combinable); In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) (Patent Office must "identify specifically . . . the reasons one of

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ordinary skill in the art would have been motivated to select the references and combine them").

In the absence of a specific reference to the prior art or declaration by Examiner establishing a motivation to combine Kilkki and Rom, Applicant is unable to (a) assess the scope of such a motivation, (b) determine the level of skill in the art, or (c) identify the presence of evidence that teaches away from the combination of Kilkki and Rom. In re Pardo, 214 USPQ 673, 677 (C.C.P.A. 1982) (allegations concerning specific "knowledge" of the prior art, which might be peculiar to a particular art must be supported by the Patent Office to provide inventor an opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference).

In the absence of any evidence of a motivation to combine, it would appear that the motivation to combine offered by Examiner merely re-states a solution/benefit revealed by the present application. Regrettably, Applicant has no alternative but to presume that Examiner has relied on impermissible hindsight in order to arrive at a combination of references that allegedly solves the same problem as the present invention. Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH, 45 USPQ 2d 1977, 1981-82 (Fed. Cir. 1998) (defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness). That is, it is Applicant's own application that discloses a system adapted to fairly allocate network devices, not the prior art.

C. REJECTION UNDER 35 U.S.C. § 103: EVERY ELEMENT

Applicant respectfully asserts that claims 1-23 are also allowable because the references, either alone or in combination, offered by Examiner do not disclose one or more features of the claimed invention. Assuming *arguendo* that Kilkki and Rom could be combined, the combination fails to disclose a data communication node adapted to perform classification at both the access controller adapted to perform preclassification that